

ESTTA Tracking number: **ESTTA389339**

Filing date: **01/20/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Ugglebo Clogs LLC		
Entity	Limited Liability Company	Citizenship	Minnesota
Address	11130 Lake Point Drive Chisago, MN 55013 UNITED STATES		

Attorney information	J. Derek Vandenburg Carlson, Caspers, Vandenburg & Lindquist 225 South Sixth Street, Suite 3200 Minneapolis, MN 55402 UNITED STATES dvandenburg@ccvl.com, akatz@belleskatz.com Phone:612-436-9600
----------------------	--

Registrations Subject to Cancellation

Registration No	3050925	Registration date	01/24/2006
Registrant	Deckers Outdoor Corporation 495-A SOUTH FAIRVIEW AVENUE GOLETA, CA 93117 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 1979/12/28 First Use In Commerce: 1979/12/28
All goods and services in the class are cancelled, namely: Men's, women's and children's footwear, namely, boots, shoes, clogs, slippers; men's, women's and children's clothing, namely, coats, jackets, ponchos; women's clothing, namely, skirts, muffs; children's buntings

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	3050903	Registration date	01/24/2006
Registrant	DECKERS OUTDOOR CORPORATION 495-A SOUTH FAIRVIEW AVENUE GOLETA, CA 93117 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 1989/01/01 First Use In Commerce: 1989/01/01
All goods and services in the class are cancelled, namely: CLEANER AND CONDITIONER FOR USE ON SHEEPSKIN AND LEATHER

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act section 2(d)	
Registration No	3050902	Registration date	01/24/2006
Registrant	DECKERS OUTDOOR CORPORATION 495-A SOUTH FAIRVIEW AVENUE GOLETA, CA 93117 UNITED STATES		

Goods/Services Subject to Cancellation

Class 001. First Use: 1989/01/01 First Use In Commerce: 1989/01/01
All goods and services in the class are cancelled, namely: WATER AND STAIN REPELLANT FOR USE ON SHEEPSKIN AND LEATHER

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act section 2(d)	
Registration No	3050865	Registration date	01/24/2006
Registrant	DECKERS OUTDOOR CORPORATION 495-A SOUTH FAIRVIEW AVENUE GOLETA, CA 93117 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2000/07/31 First Use In Commerce: 2000/07/31
All goods and services in the class are cancelled, namely: Retail store services, mail order catalog services and on-line retail store services featuring footwear, clothing, handbags and home accessories

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act section 2(d)	
Registration No	3360442	Registration date	12/25/2007
Registrant	Deckers Outdoor Corporation 495-A SOUTH FAIRVIEW AVENUE GOLETA, CA 93117 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2005/08/00 First Use In Commerce: 2005/08/00
All goods and services in the class are cancelled, namely: footwear, namely, sandals; clothing, namely, vests, mittens, scarves, headwear, caps, visors

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act section 2(d)	
Related Proceedings	None at present; there will be a Civil action filed shortly and details will be provided		

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	UGGLEBO
Goods/Services	Footwear, namely clogs and clog boots

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	UGGLEBO TOFFELN		
Goods/Services	Footwear, namely clogs and clog boots		

Attachments	Consolidated Petition for Cancellation_01-201-2011.pdf (7 pages)(303233 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Andrew B. Katz/
Name	Andrew B. Katz
Date	01/20/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UGGLEBO CLOGS, LLC,
a Minnesota LLC,

Petitioner,

v.

DECKERS OUTDOOR CORPORATION,
a Delaware Corporation,

Respondent.

Cancellation No. _____
Registration Nos. 3050925, 3050903,
3050902, 3050865 and 3360442.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

CONSOLIDATED PETITION FOR CANCELLATION

Pursuant to 37 C.F.R. § 2.112(b) and Rule 306 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP), Ugglebo Clogs, LLC ("Petitioner"), a Minnesota LLC having a principal place of business at 11130 Lake Point Drive, Chisago City, Minnesota 55013, believes that it is and will continue to be damaged by each and every one of the following five registrations on the Principal Register all covering the word mark **UGG** and hereby petitions to cancel the same pursuant to the provisions of Lanham Act § 14, 15 U.S.C. § 1064 and 37 C.F.R. § 2.112(a):

US Reg. No.	Int. Class	Description of Goods & Services
3,050,925	25	Men's, women's and children's footwear, namely, boots, shoes, clogs, slippers; men's, women's and children's clothing, namely, coats, jackets, ponchos; women's clothing, namely, skirts, muffs; children's buntings
3,050,903	3	Cleaner and conditioner for use on sheepskin and leather

3,050,902	1	Water and stain repellant for use on sheepskin and leather
3,050,865	35	Retail store services, mail order catalog services and on-line retail store services featuring footwear, clothing, handbags and home accessories
3,360,442	25	footwear, namely, sandals; clothing, namely, vests, mittens, scarves, headwear, caps, visors

All of these five registrations are registered in the name of Deckers Outdoor Corporation, a Delaware corporation with a last known address of 495-A S. Fairview Avenue, Goleta, California, 93117 ("Registrant").

In support of this petition, Petitioner alleges as follows:

Grounds for Cancellation

1. Petitioner is the owner of the marks UGGLEBO and UGGLEBO TOFFELN, used in connection with men's, women's and children's footwear, namely clogs and clog boots ("Petitioner's Goods").

2. Petitioner and its predecessors-in-interest began using the marks UGGLEBO and UGGLEBO TOFFELN in connection with Petitioner's Goods in interstate commerce in the United States at least as early as January 1, 1970 and have maintained continuous use of the marks in the United States since that time.

3. Petitioner and its predecessors-in-interest have consistently and publicly promoted its inherently distinctive marks UGGLEBO and UGGLEBO TOFFELN, in connection with its offering of Petitioner's Goods. As a result, Petitioner has developed a favorable reputation and valuable goodwill in the marks UGGLEBO and UGGLEBO TOFFELN, which identifies, distinguishes and indicates the source of Petitioner's Goods.

4. On February 5, 2010, Petitioner filed Application No. 77/929,400 for registration of the mark UGGLEBO in connection with clogs in International Class 25 ("Petitioner's US

Application”). On May 7, 2010, Petitioner’s US Application was rejected under Section 2(d) of the Lanham Act in light of two of Respondent’s Registrations, US Registration Nos. 3050925 and 3360442.¹

5. On information and belief, Respondent is a Delaware corporation having a principal place of business at 495-A S. Fairview Avenue, Goleta, California, 93117.

6. Respondent has filed for and obtained the following trademark registrations for the mark UGG for the following goods and services:

<u>Registration No.</u>	<u>Registration Date</u>	<u>Int’l Class</u>	<u>Good/Services</u>	<u>Alleged Date of First Use</u>
3,050,925	Jan. 24, 2006	25	Men's, women's and children's footwear, namely, boots, shoes, clogs, slippers; men's, women's and children's clothing, namely, coats, jackets, ponchos; women's clothing, namely, skirts, muffs; children's buntings.	Dec. 28, 1979
3,050,903	Jan. 24, 2006	3	Cleaner and conditioner for use on sheepskin and leather.	Jan. 1, 1989
3,050,902	Jan. 24, 2006	1	Water and stain repellant for use on sheepskin and leather.	Jan. 1, 1989
3,050,865	Jan. 24, 2006	35	Retail store services, mail order catalog services and on-line retail store services featuring footwear, clothing, handbags and home accessories.	July 31, 2000
3,360,442	Dec. 25, 2007	25	Footwear, namely, sandals; clothing, namely, vests, mittens, scarves, headwear, caps, visors.	Aug., 2005

The above-identified registrations are referred to herein collectively as “Respondent’s Registrations” and the above-identified goods and services are referred to herein collectively as “Respondent’s Goods and Services.” All of the goods and services listed above relate to

¹ Petitioner’s US Application is currently suspended on the basis of an additional reference cited against it belonging to a third party; however, that cited reference has since gone abandoned and it is expected that the examiner will lift the suspension and make the 2(d) rejection final in due course.

footwear or footwear products and all would be found in the same channels of trade as footwear products.

7. Upon information and belief, December 28, 1979 is the earliest date for which Respondent can establish use of the mark UGG on any of Respondent's Goods and Services.

8. Petitioner began using the marks UGGLEBO and UGGLEBO TOFFELN for Petitioner's Goods at least nine years prior to Respondent's alleged date of first use for any of Respondent's Goods and Services and several decades before Respondent's application filing date for Respondent's Registrations.

9. Petitioner's common law rights in the UGGLEBO and UGGLEBO TOFFELN marks have priority over Respondent's UGG mark and Respondent's Registrations.

10. Respondent's UGG mark is highly similar to Petitioner's UGGLEBO and UGGLEBO TOFFELN marks. The letters "U," "G," and "G" are the first three letters of Petitioner's UGGLEBO and UGGLEBO TOFFELN marks and the most distinctive and memorable part of those marks. Many consumers pronounce the "Ugg" in UGGLEBO the same as they pronounce Respondent's UGG mark, i.e., they say Ugg-le-bo or Uggly-bo.

11. Respondent's Goods and Services overlap with and/or are closely related to Petitioner's Goods. Indeed, the prosecution history of Petitioner's US Application confirms the confusingly similar relationship between Respondent's goods and services and Petitioner's goods as the examiner supported her rejection of Petitioner's US Application and several of Respondent's Marks.

12. Respondent's UGG marks, when used on or in connection with Respondent's Goods and Services, have caused confusion, mistake, and deception with Petitioner's UGGLEBO and UGGLEBO TOFFELN marks as used by Petitioner in connection with

Petitioner's Goods. Consumers believe that UGGLEBO brand footwear and UGG brand footwear and other of Respondent's Goods bearing the UGG mark are from the same source, or that there is some sponsorship, connection or association between Petitioner and Respondent. Other consumers as well as some wholesalers, retailers, and consumers have concluded that Petitioner is attempting to trade on the UGG mark causing them not to buy UGGLEBO products and diminishing the good will in the UGGLEBO and UGGLEBO TOFFLEN marks. Respondent's use of the UGG mark on Respondent's Goods and Services has diminished and will continue to diminish the value of the UGGLEBO and UGGLEBO TOFFLEN marks.

13. Petitioner has been damaged, in part, because Respondent's Registrations should not have been permitted under Section 2(d) of the Lanham Act, given Petitioner's prior use of, and common law rights in, its prior and senior marks, UGGLEBO and UGGLEBO TOFFELN, and damages Petitioner's ability to fully enjoy the benefits of its prior marks without a resulting likelihood of confusion.

14. Petitioner has further been damaged because its application for registration of the UGGLEBO mark has been denied in light of two of Respondent's Registrations, and could potentially be denied registration based on the other three marks to which this petition to cancel pertains.

WHEREFORE, Petitioner believes that it is damaged by continued registration of Respondent's Registrations respectfully requests that the Board grant its consolidated petition for cancellation of Respondent's Registrations pursuant to § 14 of the Lanham Act, 15 U.S.C. § 1064.

This Petition for Cancellation is hereby filed electronically and the fee also paid electronically. Petitioner hereby authorizes the U.S. Patent and Trademark Office ("PTO") to charge PTO Deposit Account No. 503656 if the electronic payment is insufficient for any reason. The undersigned attorney for Applicant is an authorized user of this Deposit Account.

Dated: January 20, 2011

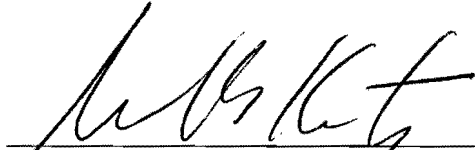
Respectfully submitted,

CARLSON, CASPERS, VANDENBURGH &
LINDQUIST

Alan G. Carlson
J. Derek Vandenburg, USPTO Reg. No. 32,179
225 South Sixth Street, Suite 3200
Minneapolis, MN 55402
Telephone: (612) 436-9600
Facsimile: (612) 436-9605

And

BELLES KATZ LLC



Andrew B. Katz, USPTO Reg. No. 34,200
721 Dresher Road, Suite 1100
Horsham, Pennsylvania 19044
Telephone: (215) 658-1890
Facsimile: (888) 649-7733
akatz@belleskatz.com

COUNSEL FOR PETITIONER
UGGLEBO CLOGGS, LLC,


CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 20th day of January, 2011 a true and correct copy of the foregoing Consolidated Petition for Cancellation (along with this Certificate of Service) was sent by first class mail, postage pre-paid to:

Deckers Outdoor Corporation
495-A S. Fairview Avenue
Goleta, California, 93117

And

Paul G. Juettner, Esq.
Tom Fitzsimons, Esq.
Greer, Burns & Crain, Ltd.
300 S. Wacker Drive Suite 2500
Chicago, Illinois 60606-6771



Andrew B. Katz